

Remarks

Applicant notes that the Examiner has not presented any rejection for claims 13-16 in the instant Office Action; as such, Applicant submits that claims 13-16 should be identified as allowable. Moreover, as discussed below, the rejections of claims 1-12 cannot be maintained because the proposed modification of the '212 reference renders it unsatisfactory for its intended purpose. In the previous Response, Applicant discussed this proposed modification of the '212 reference and Applicant explicitly explained to the Examiner why it would be inappropriate to modify the '212 reference by replacing capacitor C1 of Fig. 2 with a non-electrolytic capacitor. The relevant portion of Applicant's previous Response reads as follows:

As a general example, because the Kayser reference is directed to supplying large amounts of power (e.g., 85 to 265 VAC as indicated at Col. 1:46-49), it would be illogical for a skilled artisan to modify/replace the storage capacitor (C1) of Figs. 1 and 2 with a non-electrolytic capacitor which would be incapable of handling the stored charge as intended by the Kayser reference. While this substitution has not been advanced, Applicant notes that this difference is strong evidence that the Kayser reference teaches away from the asserted combination of teachings (each of which is based on Figs. 1 and 2 of the Kayser reference). As discussed in the M.P.E.P., the evidence teaches away from the asserted combination of teachings when the asserted modification of the primary reference would undermine the purpose or operation of the primary reference. Page 6 of the Response dated November 4, 2008.

The Examiner proceeded to propose just such a modification of the '212 reference without addressing Applicant's previous arguments as required, for example, by M.P.E.P. § 707.07(f) ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."). Applicant further directs the Examiner to M.P.E.P. § 706.07, which states that "(t)he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Applicant submits that the Examiner, in proposing a modification of the '212 reference that was already anticipated and addressed by Applicant, has not afforded Applicant "a full and fair hearing" and, as such, the rejections of claims 1-12 must be withdrawn.

The Final Office Action dated November 21, 2008, lists the following rejections: claims 1-7 and 12 stand rejected under 35 U.S.C. § 103(a) over the Kayser reference (U.S. Pat. No. 6,295,212) in view of TNY25x Datasheet by Power Integrations; and claims 8-11 stand rejected under 35 U.S.C. § 103(a) over the Kayser reference in view of TNY25x Datasheet by Power Integrations and further in view of the TEA152X family data sheet by Philips. The Office Action also notes that the title to the Specification is not descriptive and that a new title is required. Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejection of claims 1-12 because the modification of the '212 reference proposed by the Examiner would render the '212 reference unsatisfactory for its intended purpose. *See, e.g.*, M.P.E.P. § 2143.01 ("If (a) proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)"). The Examiner alleges that capacitor C1 from FIG. 2 of the '212 reference corresponds to Applicant's filter while acknowledging the capacitor C1 is not a non-electrolytic capacitor as required by the claimed invention. The Examiner then appears to propose modifying the '212 reference by replacing capacitor C1 with a non-electrolytic capacitor.¹ The '212 reference, however, is directed to supplying large amounts of power (*e.g.*, 85 to 265 VAC as indicated at Col. 1:46-49); thus, it would be illogical for a skilled artisan to modify/replace the storage capacitor C1 of Fig. 2 with a non-electrolytic capacitor which would be incapable of handling the stored charge as intended by the '212 reference. As such, there is no motivation for the skilled artisan to modify the '212 reference in the manner proposed by the Examiner. Accordingly, the § 103(a) rejection of claims 1-12 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 103(a) rejection of claims 2 and 12 because the skilled artisan would not routinely experiment with such values of the storage capacitor C1 from Fig. 2 of the '212 reference since the storage capacitor C1 is an electrolytic

¹ Applicant notes that the Examiner does not identify how the '212 reference is being modified. As such, should the Examiner be proposing some other as of yet unidentified modification of the '212 reference, Applicant requests clarification and an opportunity to respond by way of a new Office Action.

capacitor. As noted above, a non-electrolytic capacitor having a capacitance of 100 nF, as claimed, would be incapable of handling the stored charge as intended by the '212 reference, and therefore it would be illogical for the skilled artisan to implement a capacitor having such a capacitance for the storage capacitor C1 of Fig. 2. As such, the § 103(a) rejection of claims 2 and 12 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 103(a) rejection of claim 3 because no valid reason has been presented as to why the skilled artisan would seek to incorporate inductor L1, resistor R1, capacitor C1 and capacitor C2 the π -filter shown in Fig. 11 of the TNY25x Datasheet into the circuit shown in Fig. 2 of the '212 reference, particularly when the function served by the π -filter of the TNY25x Datasheet is already performed by other means in the '212 reference. As taught in the TNY25x Datasheet, the π -filter shown in Fig. 11 is part of EMI filtering circuitry. *See, e.g.*, page 7. The '212 reference, however, already addresses EMI by controlling discharge of the storage capacitor (C1) only during the intervals when the diode (D1) is not conducting (*see, e.g.*, Col. 2:19-44). As such, addition of the EMI filtering circuitry from the TNY25x Datasheet would be superfluous, and thus unmotivated. Accordingly, the § 103(a) rejection of claim 3 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 103(a) rejection of claim 5 because the cited combination does not correspond to aspects of the claimed invention directed to the coil and the non-electrolytic capacitor being arranged to filter distortions caused by the switched mode power supply. The Examiner cites to inductor L1 and capacitors C1 or C2 of Fig. 11 of the TNY25x Datasheet; however, the cited portions of this reference do not disclose that any of these components are arranged to filter distortions caused by a switched mode power supply. *See, e.g.*, page 7. Moreover, Fig. 11 of the TNY25x Datasheet indicates that both capacitors C1 and C2 are electrolytic capacitors, whereas the claimed invention recites a non-electrolytic capacitor. Thus, the § 103(a) rejection of claim 5 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 103(a) rejection of claims 6 and 12 because the cited combination does not correspond to aspects of the claimed invention directed to a coil and an inrush resistor that are connected in parallel between a non-electrolytic

capacitor and an electrolytic capacitor. The Examiner cites to inductor L1, resistor R1 and capacitor C1 of Fig. 11 and to capacitor C1 of Fig. 9 both from the TNY25x Datasheet; however, the TNY25x Datasheet does not teach that inductor L1 and resistor R1 are connected in parallel between capacitor C1 of Fig. 11 and capacitor C1 of Fig. 9. In fact, Fig. 11 of the TNY25x Datasheet shows that inductor L1 and resistor R1 are connected between two electrolytic capacitors C1 and C2, instead of between a non-electrolytic capacitor and an electrolytic capacitor as required by the claimed invention. Moreover, the Examiner fails to provide any reason why the skilled artisan would combine capacitor C1 of Fig. 9 with inductor L1, resistor R1 and capacitor C1 of Fig. 11, and further fails to provide any reason why the skilled artisan would combine the cited components of the TNY25x Datasheet with the primary '212 reference. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) ("A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art."). As such, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, the § 103(a) rejection of claims 6 and 12 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 103(a) rejection of claim 6 because the cited combination does not correspond to aspects of the claimed invention directed to the filter providing a DC output voltage at a circuit node connecting the inrush resistor and one electrode of the electrolytic capacitor, with the switched mode power supply IC being arranged to receive the DC output voltage. The cited portions of the TNY25x Datasheet do not teach a DC output voltage at the node that connects resistor R1 and C1 in Fig. 11; instead, the TNY25x Datasheet teaches that a high voltage DC is provided to T1 from the node connected to the opposite end of capacitor C1 as resistor R1. *See, e.g., page 7.* Applicant submits that any combination of the inductor L1, resistor R1 and capacitor C1 of Fig. 11 with the '212 reference would not result in IC 20 of Fig. 2 being arranged to receive any DC voltage from the node connecting resistor R1 and C1 as shown in Fig. 11 of the TNY25x Datasheet. Accordingly, the § 103(a) rejection of claim 6 is improper and Applicant requests that it be withdrawn.

Regarding claims 8-11, Applicant submits that the TEA152X reference fails to cure the deficiencies noted above with respect to the '212 reference and the TNY25x

Datasheet. Moreover, the TEA152X reference discloses only the use of a full bridge rectifier, and does not teach or suggest the use of a single diode rectifier as recited in Applicant's claims. The Examiner has provided no evidence that a SMPS IC such as shown in the TEA152X reference could be used with anything other than a full bridge rectifier as taught in the TEA152X reference. Applicant submits that Applicant's own Specification provides the only support on the record for the use of a single diode rectifier with a SMPS IC such as shown in the TEA152X reference. Accordingly, the § 103(a) rejection of claims 8-11 is improper and Applicant requests that it be withdrawn.

Applicant respectfully requests clarification regarding how the Examiner is proposing to combine the cited references. Applicant notes that the Office Action simply identifies components from Fig. 2 of the '212 references and from multiple embodiments of the TNY25x Datasheet (*e.g.*, Figures 9 and 11) without providing any explanation regarding how these components are being combined. In order to comply with 35 U.S.C. § 132, sufficient detail must be provided by the Examiner regarding the alleged correspondence between the claimed invention and the cited reference to enable Applicant to adequately respond to the rejections. *See, also*, 37 CFR 1.104 ("The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.") and M.P.E.P. § 706.02(j), ("It is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."). In this instance, it is unclear to Applicant how the cited portions of the references are being combined by the Examiner, for example, is the π -filter shown in Fig. 11 of the TNY25x Datasheet being incorporated into the circuit shown in Fig. 2 of the '212 reference before or after diode D1, is the capacitor C1 of Fig. 9 of the TNY25x Datasheet being placed in the circuit shown in Fig. 2 of the '212 reference before or after diode D1, and is the capacitor C1 replacing capacitor C1 shown in Fig. 2 or simply being added to the circuit of Fig. 2 in some as of yet unidentified manner. As such, Applicant respectfully requests clarification by way of a new Office Action.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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